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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,661	04/02/2004	Jin Kyu Choi	1594.1319	8208
21171	7590	02/22/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			TRIEU, THERESA	
			ART UNIT	PAPER NUMBER
			3748	

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/815,661	CHOI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Theresa Trieu	3748	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-26 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) 1-3 and 11-14 is/are rejected.  
 7) Claim(s) 4-10, 15-26 is/are objected to.  
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>April 2, 2004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 11 recite the limitation "a locking pin to change a position of the first or second eccentric bush to maximum eccentric position" renders the claims indefinite, because it is unclear in which condition the first eccentric bush changes to a maximum eccentric portion and in which condition the second eccentric bush changes to a maximum eccentric portion and how the locking pin changes the position of the first/second eccentric bush; as applicants have claimed

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

*Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-3 and 11-14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 22 of copending Application No. 10/807,285. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 22 of the copending application "anticipates" application claims 1-3 and 11-14. Accordingly, application claims 1-3 and 11-14 is not patentably distinct from copending application claims 1 and 22. Here, copending application claims 1 and 22 requires elements a rotating shaft, first and second eccentric cams, first and second eccentric bush, a cylindrical connecting part comprising a slot, a locking pin and a restraining unit to fit over the locking pin while application claims 1-3 and 11-14 only requires a rotating shaft, first and second eccentric cams, first and second eccentric bush, a cylindrical connecting part comprising a slot and a locking pin. Thus it is apparent that the more specific copending claims 1 and 22 encompasses application claims 1-3 and 11-14. Note that since application claims 1-3 and 11-14 is anticipated by copending application claims 1 and 22 and since anticipation is the epitome of obviousness, then application claims 1-3 and 11-14 is obvious over copending application claims 1 and 22. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3 and 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Cho et al. (Cho) (Patent Number 6,860,724).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Regarding claims 1-3 and 11-14, as shown in Figs. 3-16, Cho discloses a variable capacity rotary compressor, comprising: first and second compression chambers (308a, 308b) having different capacities; a rotating shaft (301) passing through the first and second compression chambers; first and second eccentric cams (301a, 301b) eccentrically mounted to the rotating shaft to be placed in the first and second compression chambers, respectively; first

and second eccentric bushes (306a, 306b) fitted over the first and second eccentric cams, respectively, to cause an eccentric line of the first eccentric bush to cross an eccentric line of the second eccentric bush; first and second rollers (305a, 305b); and a locking pin (501, 701) being positioned between the first and second eccentric cams (301a, 301b) to change a position of the first or second eccentric bush (306a, 306b) to a maximum eccentric position, according to a rotating direction of the rotating shaft; an angle between a maximum eccentric part of the first eccentric bush (306a) and a maximum eccentric part of the second eccentric bush (306b) is less than 180° in a rotating direction of the first or second eccentric bush which executes a compression operation; the first and second eccentric bushes (306a, 306b) being integrated with each other by a connecting part (502, 702 (Fig. 14); 150, 151 (Figs. 15 and 16)) which connects the first and second eccentric bushes (306a, 306b) to each other; the connecting part (502, 702 (Fig. 14); 150, 151 (Figs. 15 and 16)) comprises a slot (not numbered; however, clearly seen in Fig. 15), including first and seconds ends, having a predetermined length, formed around the connecting part (150, 151, see Fig. 15 and 16).

*Allowable Subject Matter*

4. Claims 4-10 and 15-26 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Prior Art*

The IDS (PTO-1449) filed on April 2, 2004 has been considered. An initialized copy is attached hereto.

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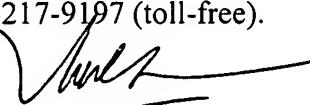
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and consists of five patents: Hagerty (U.S. Patent Number 713,301), Rolaff (U.S. Patent Number 1,789,842), Monk et al. (U.S. Patent Number 6,099,259), Saito et al. (Publication Number JP 62-70686), and Kosokabe et al. (Publication Number JP 62-078499), each further discloses a state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theresa Trieu whose telephone number is 571-272-4868. The examiner can normally be reached on Monday-Friday 8:30am- 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on 571-272-4859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TT  
February 9, 2006

  
Theresa Trieu  
Primary Examiner  
Art Unit 3748